

Application Serial No. 10/790,417  
Filed March 1, 2004  
Response and Amendment dated January 4, 2008  
Confirmation No. 1471  
Attorney Docket No. MESK-30

### **REMARKS**

Claims 1-60 are pending in the application. The Examiner has rejected claims 1-7, 20-21, 23, 25-29, 31, 32, 34, 35, 37-42, and 45. The Examiner has objected to claims 8-19, 22, 24, 30, 33, 36, 43-44, and 46-60. Claims 4, 8, 13, 17, 24, 27, 30, 33, and 36 are presently amended. Claims 1-3, 6, 20, 21, 23, 25, 26, 29, 31, 32, 34, and 35 are presently cancelled. A terminal disclaimer is also submitted herewith. In view of the amendments, the terminal disclaimer, and the discussion below, it is submitted that the application is now in condition for allowance.

### **Claim Objections**

The Examiner has objected to claims 8-19, 22, 24, 30, 33, 36, 43-44, and 46-60 as being dependent on a rejected base claim, but otherwise being allowable if rewritten to include the limitations of the base claim and any intervening claims.

In response, Applicant has presently amended claims 4, 8, 13, 17, 24, 30, 33, and 36. Further, as will be discussed below, Applicant has also submitted a terminal disclaimer to render moot the rejections of claims 1-7, 20, 21, 27, 28, 37-42, and 45 for double patenting. In view of these amendments, and the terminal disclaimer, Applicant submits that each of claims 8-19, 22, 24, 30, 33, 36, 43-44, and 46-60 have either been amended to include all the limitations of the base claim and any intervening claim, or the rejection of the base claim has been rendered moot due to the terminal disclaimer.

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### **Double Patenting**

The Examiner has provisionally rejected claims 1-7, 20, 21, 27, 28, 37-42, and 45 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 40-45 of copending U.S. Patent Application No. 10/374,594. The Examiner states that although the conflicting claims are not identical, they are not patentably distinct from each other.

In response, Applicant submits herewith a terminal disclaimer, disclaiming the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending reference Application No. 10/374,594.

In view of the above, Applicant submits that the obviousness-type double patenting rejection of claims 1-7, 20-21, 27-28, 37-42, and 45 has been overcome. Applicant therefore requests a withdrawal of the rejection of those claims for obviousness-type double patenting.

### **Claim Rejections 35 U.S.C. §§ 102/103**

The Examiner has rejected claims 1-3, 6, 20, 21, 23, 25, 26, 29, 31, 32, 34, and 35 as either anticipated or obvious over cited art. In particular, the Examiner has rejected claims 1, 23, 29, and 31 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,595,970 (Garfield). The Examiner has rejected claims 1-3, 23, 29, and 31 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,906,987

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(Chwalisz). And, the Examiner has rejected claims 1-3, 6, 20, 21, 23, 25, 26, 29, 31, 32, 34, and 35 under 35 U.S.C. § 103(a) as being unpatentable over Garfield in view of Chwalisz, and in further view of Coral-Cure [www.coral-cure.com/mens-health](http://www.coral-cure.com/mens-health) (Coral-Cure) and Chen et al. Exp. Opin. Ther. Patents, Therapeutic Patents for Topical and Transdermal Drug Delivery Systems (Chen).

Only claims 1-3, 6, 20, 21, 23, 25, 26, 29, 31, 32, 34, and 35 are substantively rejected over the cited art. In response, Applicant has presently cancelled claims 1-3, 6, 20, 21, 23, 25, 26, 29, 31, 32, 34, and 35. Thus, Applicant submits that the rejections over the cited art are rendered moot, and requests a withdrawal of those rejections.

Following the cancellation of these claims, only claims 4, 5, 8-19, 22, 24, 27, 28, 30, 33, and 37-60 remain. Those claims have been stated by the Examiner to be either (1) allowable but objected to as being dependent on a rejected base claim, or (2) only rejected for obviousness-type double patenting in view of the '594 application. In view of the present amendments to the claims that have been objected to in order to rewrite those claims to include the limitations of the base claim and any intervening claims, and in view of the terminal disclaimer filed herewith to overcome the double patenting rejection, Applicant submits that claims 4, 5, 8-19, 22, 24, 27, 28, 30, 33, and 36-60 are in condition for allowance.

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### **Conclusion**

For the foregoing reasons, it is submitted that all claims are patentable, and a Notice of Allowance is respectfully requested.

The terminal disclaimer fee of \$65.00 is submitted herewith. Any deficiencies or credits necessary to complete this communication should be applied to Deposit Account No. 23-3000.

The Examiner is invited to contact the undersigned attorney with any questions or remaining issues.

Respectfully submitted,  
WOOD, HERRON & EVANS, L.L.P.

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